



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,397	12/06/2007	Vera Lauper	741439-38	7176
22204	7590	04/07/2009		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER	
			ELHELO, EISA B	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			04/07/2009 PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/587,397

Applicant(s)

LAUPER, VERA

Examiner

Eisa B. Elhilo

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 10/15/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claims 1-8 are pending in this application.

DETAILED ACTION

Claim Objections

1. Claims 1, 3, 5 and 6 objected to because of the following informalities:

Claims 1, 5 and 6 recites the limitation “e.g.” this term should be deleted to make the claims in a proper form. Appropriate correction is required.

Claim 3, recites the limitation “1 and/or 2”. The claim should refer to other claims in the alternative only, and/or, can not depend from any other multiple dependent claims. Appropriate correction is required.

Double Patenting

2 The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No.

10/820,658. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending Application No. 10/820,658, teach and disclose methods for producing hair colorants by mixing and dissolving dyeing ingredients such as oxidative dyes, couplers, alkaline agents and oxidizing agents using a computer-controlled device for mixing the dyeing ingredients as claimed in claims 1-8 (see claims 1-10 of the copending application No. 10/820,658). Therefore, this is an obvious method.

Although, the claims of the copending application No. 10/820,658, teach and disclose methods for preparing a dye composition similar to those claimed, they are not identical to the instant claims because the claims of the copending application No. 10/820,658, comprising the step of providing a plurality of dyes. Therefore, the conflicting claims are not identical.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize such a method for producing the hair dyes by mixing the dyeing ingredients using the computer device because the claims of the copending application No. 10/820,658, clearly teach and suggest the use of computer device to mix the similar dyeing ingredients, and, thus, a person of the ordinary skill in the art would expect such a method to have similar properties to those claimed, absent unexpected results.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dias (US 6,540,791 B1) in view of Birner et al. (DE 101 14060 A1).

Dias (US' 791 B1) teaches a method for manufacture (producing) a dyeing composition comprising oxidative dyes and non-oxidative dyes (direct dyes) as claimed in claim 1 (see col. 31, lines 44-51), oxidizing agents as claimed in claim 3 (see col. 5, lines 7-11) and alkalizing agents such as ammonium hydroxide and mono-ethanolamine in the amounts of 0.1 to 20% which overlapped with the claimed range as claimed in claim 3 (see col. 7, lines 35-42) and wherein the dyeing composition is prepared by any known or otherwise effective technique suitable for providing a hair bleaching and/or coloring composition (see col. 47, lines 53-64) and wherein the dyeing ingredients are pre-solubilized in the diluents at about 60 °C to about 80 °C to create a main emulsion and separately a secondary phase containing the oxidant and alkalizing and buffering components is prepared at about 20 °C to about 40 °C and the main emulsion phase is then cooled after adding perfumes and stored in a kit of device as claimed in claims 4-8 (see col. 48, lines 1-65).

The instant claims differ from the reference by reciting a method for preparing a dyeing composition using a computer-controlled device.

However, Dias clearly teaches that the dye composition may be prepared by any known or otherwise effective technique (see col. 47, lines 53-55).

Birner et al. (DE' 060 A1) in analogous art of hair dyeing formulation, teaches a method for determining the quantity of dye, mixing the determined volume of chemicals in a machine

(computer) and supplying the dye for application to the customer (see English abstract of the Patent DE' 060 A1).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art at the time the invention was made would be motivated to formulate a dyeing composition of Dias by utilizing the technique taught by Birner et al. to arrive at the claimed invention because Dias clearly teaches that the dyeing composition may be prepared by any suitable technique (see col. 47, lines 53-55). Birner et al. as a secondary reference clearly teaches and suggests the use of a machine (computer) as a technique for controlling the quantity, determining and mixing the dyeing ingredients and supplying the dye for application to the customer, and, thus, a person of the ordinary skill in the art would expect such a process to have similar properties to those claimed, absent unexpected results.

Conclusion

4 The remaining references listed on from PTO-1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B. Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Eisa B Elhilo/
Primary Examiner, Art Unit 1796
April 4, 2009